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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,699	07/27/2006	Ulrich Bauch	2004P00851	3533
24131 7590 11/24/2008 LERNER GREENBERG STEMER LLP P O BOX 2480 HOLLYWOOD, FL 33022-2480				
EXAMINER				
FISHMAN, MARINA				
ART UNIT		PAPER NUMBER		
2832				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/587,699

Applicant(s)

BAUCH ET AL.

Examiner

Marina Fishman

Art Unit

2832

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 10, 12-15, and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 10, 12-15, and 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-083)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

General status

1. This is a Final Action on the Merits. Claims 9, 10, 12-15, and 17 - 22 are pending in the case and are being examined.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9, 10, 12-15, and 17 - 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piazza et al. [US 6,784,392] in view of Cronin et al. [US 4,300,028].

Regarding Claims 9 and 17, Piazza et al. [Figures 1 - 3] disclose a high-voltage outdoor bushing configuration, comprising:

- an axis [along insulator 40, Figure 2] extending through the outdoor bushing configuration;
- an electrically insulating casing [99, Figure 3];
- a switch-disconnector module [100] having an electrically conductive housing;
- a phase conductor [2] extended along the axis and to be interrupted by an isolating gap into a first section and a second section [Figure 3, first section 2, second section at 96]; and

- a switching piece or an element [94, Figure 4] of a multi-part switching piece to be moved at an angle relative to the axis, the switching piece being driven by a shaft [93] passing through electrically conductive housing.

Regarding Claims 9 and 17, Piazza et al. disclose the instant claimed invention except for the conductive housing being substantially cylindrical and extending coaxially around the axis. Cronin et al. [Figure 1] disclose disconnecter [43, 44] having substantially cylindrical housing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a substantially cylindrical housing in Piazza et al., as suggested by Cronin et al., so as to make manufacturing easier. Although it is not clear from Piazza et al. [Figure 3], if smaller diameter shaft is a part of motor or the shaft [93]. It would have been obvious to extend the shaft portion beyond the outer wall [flange], so as to be accessible from outside the housing so that the shaft can be coupled to the motor [90].

Regarding Claims 10 and 18, Piazza et al. disclose a grounding switch [Figure 4, 94, 95, Column 3, lines 26 - 29] disposed within the electrically conductive housing, the grounding switch grounding at least one of the sections by continuation of a further movement of the switching piece [94]. Regarding Claims 12, 19, Piazza et al. disclose the switching piece [94] is a blade contact. Regarding Claim 13, Piazza et al. disclose the switching piece is pin-shaped [35, Figure 7, 8]. Regarding Claims 14, 21, Piazza et al. disclose a pillar supports [Figure 3, not numbered connected to 93] holding the

isolating gap in the housing. Regarding Claims 15, 22, Piazza et al. disclose the switching piece is movable on a curved path [94 rotates].

Response to Arguments

4. Applicant's arguments filed 9/30/08 have been fully considered but they are not persuasive.

The Applicant has argued, that (a) the modification of the Piazza reference suggested in the Office Action would impermissibly destroy the teachings of that reference, (b) the proposed modification cannot render the prior art unsatisfactory for its intended purpose, and (c) the proposed modification cannot change the principle of operation of a reference. Examiner respectfully disagrees with each of the arguments. The Applicant has pointed to the limitation "substantially cylindrical" in the claim and the modification the Examiner made by using the teaching of Cronin reference. The Applicant pointed to Piazza reference, column 3, lines 19-25 and recited the text from that column, however, there is nothing in the text that suggests that the principle of operation will be changed, by modifying substantially spheroidal central portion to substantially cylindrical shape, and the Examiners is of the opinion that the disconnecter will still function as a disconnecter. While discussing arguments (b) and (c), the Applicant has cited text from Piazza reference column 3, lines 61 to column 4, line 2 and pointed to "substantially spheroidal shape of the enclosure 99 allow to optimize the distribution of the electric field inside disconnection unit, without requiring cumbersome constructive elements." The Examiner again respectfully disagrees, as (i) none of the claim recites "optimization of distribution of electric field", and therefore, that should not

be an issue, and also (ii) the enclosure 99 is generally grounded and therefore, it is not clear, how the "optimization of distribution of electric field" will change by changing the enclosure from spheroidal shape into cylindrical shape. In addition, the changing of spheroidal shape into cylindrical shape will make manufacturing easier.

Regarding Claims 9 and 11, the Applicant has also argued, that the teachings of the Piazza and Cronin references do not teach or suggest, among other limitations of Applicants' claims, Applicants' particularly claimed outdoor bushing configuration arranged on an axis. Examiner respectfully disagrees, as Piazza, does disclose the outdoor bushing extending along the axis [Piazza, Figure 3].

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Fishman whose telephone number is (571)272-1991. The examiner can normally be reached on 7-5 M-T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on 571-272-1990. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elvin G Enad/
Supervisory Patent Examiner, Art Unit 2832

/Marina Fishman/
Examiner, Art Unit 2832
November 18, 2008

